

DOCKET NO.: UC 0409 US NA
Application No.: 10/782,357
Office Action Dated: May 29, 2007

Patent

Remarks

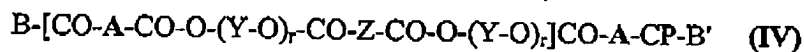
Claims 1-25 are pending. Claims 9, 12-13, 17, 20-23 and 25 are rejected as anticipated by a reference.

Claims 9, 12-13, 17, 20-23 and 25 Not Anticipated by Katsumi

Claims 9, 12-13, 17, 20-23 and 25 stand rejected under 35 U.S.C. § 102(b) as anticipated by JP 2000-143786 (Katsumi). Katsumi discloses a polyester having charge transport properties and which is useful as a photoconductor for electrophotography. The polyester has substructure repeating units from a dicarboxylic acid and substructure repeating units from a diol, which are joined by ester linkages. The polymers have an average molecular weight in the range of 10,000 to 300,000. By contrast, in Applicants' Formula III, as recited in independent Claims 9 and 20, there are no ester linkages.

The Examiner has further pointed to one structure, which Applicants believe corresponds to Kasumi's I-44. This is a substructure, not the polyester polymer having charge transport properties. There is no teaching in Katsumi of the use of the substructures alone, only of the polyester polymer. Furthermore, even if the substructure were to be considered alone, it is not the same as Applicants' Formula III. The Katsumi compound has an ester substituent on a phenyl ring attached to nitrogen. In Applicants' Formula III, neither R¹ (attached directly to the nitrogen) nor R² (attached to a phenyl group attached to the nitrogen) includes an ester group. R¹ is selected from aryl, heteroaryl, fluoroaryl, and fluoroheteroaryl. R² is selected from H, R1, alkyl fluoroalkyl, Cl, Br, I, and arylamino.

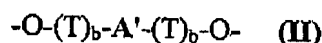
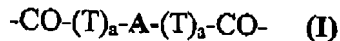
Please refer, in particular, to paragraphs [0005] and [0008] of Katsumi. The substructure A is shown as a component of Formula III or Formula IV in [0005], as follows:



Paragraph [0008] shows A as a component in Formulas I and II, which are, themselves, substructures of a larger polyester which are both required for the polymer (see, for example, claims 1 and 3 of Katsumi):

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Referring, for example, to Table 4, page 9, compounds I-43, I-44 and I-45: the values for X, R₁, R₂, R₃, [unknown, cannot translate], k, a, m and T are shown. T-2 (an ethylene group) is shown on page 4; Applicants' counsel was unable to locate T-51 in the translated disclosure (T-5 is a 1-methylethylene, if that is what was intended). These values are clearly meant to be applied to Formula I, shown above, since subscript a rather than b is presented (the subscript a is also present in Formula V, page 19, and b is also present in Formula VI on the same page). Compound I-46 is shown in Table 5, page 10, where each R is methyl and T is T-2, again, these are clearly applicable to Formula I or Formula V as well. Compounds I-89 through I-91 are shown on the Tables on page 12. Three of these compounds use T-2 and one uses T-51, and k = a = m = 1 in each case (Formula I or V). Compounds II-43 – II-46 are shown on the tables on pages 15 and 16. In three of these compounds, T = T-4 (propylene) and in one instance, T = T-7 (butylene), and these compounds are applicable to Formula II or Formula VI. Finally, the Tables on page 18 show II-89 – II-92. In each instance, k = b = m = 1 and in three instances, T = T-4 and in one instance, T = T-7. These exemplars are apparently applicable to Formulas II or VI. There are applications where A may appear in Formula III or Formula IV, as well, though it is not deemed necessary to analyze these in light of the foregoing remarks. There are also applications of A and A' in Formulas V and VI on page 19, which require no further analysis since these also are clearly distinct from the claimed subject matter.

Accordingly, Katsumi presents A as a linking component in a larger polymer, and does not teach or suggest the use of A in its various permutations as a molecule with its own use or utility.

Applicants respectfully submit that Katsumi does not teach or suggest the compound of Claim 9 or the composition of Claim 20, or the claims dependent thereon.

Pending Claims Should be Examined on the Merits Notwithstanding Double Patenting Rejection

Claims 1-23 and 25 stand rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as Claims 1-7 and 9 of copending Application No. 11/093,455 ('455 Application). Applicants respectfully maintain their traverse of this rejection for reasons already made of record.

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In addition, the present application has an earlier effective filing date than the '455 application, and Applicants respectfully believe that the prosecution can best be advanced by allowing this application to issue and rejecting the '455 Application for double patenting, if appropriate. See MPEP §804. Accordingly, this application should be examined in its entirety, on the merits, notwithstanding the double patenting rejection which is, as stated appropriately in the Office Action, a provisional rejection.

Allowable Subject Matter

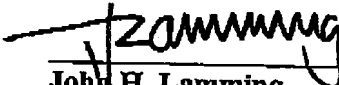
Applicants acknowledge, with appreciation, the Examiner's indication that claim 24 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Applicants forbear from amending claim 24 at this time, since Applicants believe that the rejections over Katsumi have been overcome, and that such amendment may prove, in the end, to be unnecessary.

Conclusion

The Examiner is invited to call the undersigned if clarification is needed.

Respectfully submitted,

Date: August 29, 2007


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